



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/574,563

04/04/2006

Satoshi Kobayashi

Q94204

1890

23373 7590 12/23/2008
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

KOSACK, JOSEPH R

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

12/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,563	Applicant(s) KOBAYASHI ET AL.	
	Examiner Joseph R. Kosack	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2 and 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/04/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-7 are pending in the instant application.

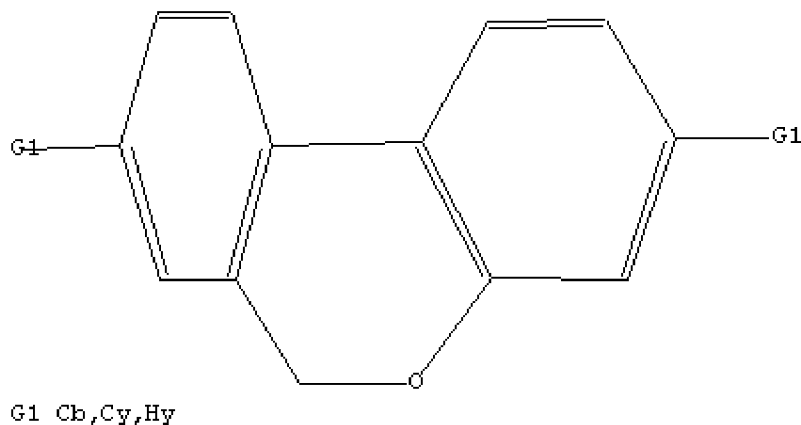
Election/Restrictions

Applicant's election without traverse of Group IV (claims 3 and 4 in part) along with an election of species in the reply filed on September 11, 2008 is acknowledged. Claims 1, 2, and 5-7 are withdrawn from further consideration by the Examiner under 37 CFR 1.142(b) as being drawn to a non-elected invention.

During the search of the elected group, the Examiner was unable to search the entire genus of Group IV due to limitations with the structure search software. Therefore, the search has been limited to the following core structure of formula 6 which was able to be searched by the search software:

- A1 is -Z2-Z3-;
- Z2 is C(R1)(R2);
- Z3 is O;
- Ar4 and Ar5 are phenyl rings where the Ar4-Ar5 bond is ortho to the bond with A1;
- Ar6 and Ar7 are connected para to the Ar4-Ar5 bond to Ar4 and Ar5 respectively;
- All other groups are as defined.

A structural representation of the above described genus is



where G1 is Ar6 and Ar7

from the instant claims. The non-searched subject matter cannot and will not be searched in the instant application. It is suggested to the Applicant to cancel the non-searched subject matter and pursue the non-searched subject matter in a divisional application. The non-searched portions of claims 3 and 4 are also withdrawn from consideration by the Examiner under 37 CFR 1.142(b) as being drawn to a non-elected invention.

Priority

The claim to priority as a 371 filing of PCT/JP04/15001 filed on October 5, 2004, which claims priority to JP 2003-346688 filed on October 6, 2003 is acknowledged in the instant application.

Information Disclosure Statement

The Information Disclosure Statement filed on April 4, 2006 has been considered by the Examiner, however the Foreign Patents and Non Patent Literature have not been considered as copies of the documents have not been provided to the Office as

Art Unit: 1626

required by 37 CFR 1.98(a)(2). Those documents have been lined out in the copy accompanying this action.

Claim Objections

Claims 3 and 4 are objected to for containing elected and non-elected subject matter. The elected subject matter has been identified supra.

Claim Rejections - 35 USC § 112

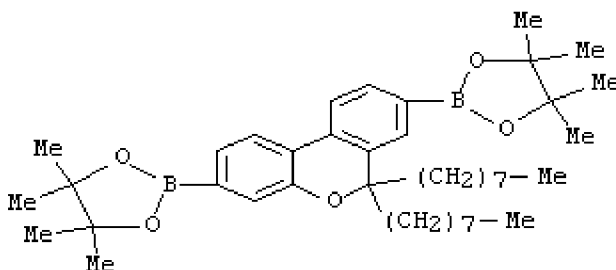
The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 recites the limitation "wherein A1 and X3 represent the same meaning as described above". There is insufficient antecedent basis for this limitation in the claim because claim 3 is an independent claim and it is not directed to refer to any other particular source (claim, specification, drawings) for the definition of A1 and X3. It is suggested that the Applicant insert the proper definition for A1 only into claim 3 to overcome the rejection since X3 is part of the non-elected subject matter. As claim 4 depends off of claim 3, the rejection is effective for claim 4 as well.

Closest Prior Art

The closest prior art is that of Doi et al. (WO 2004/398590) which teaches a



compound of the formula

which does not

Art Unit: 1626

teach the proviso that one group off of the Ar6 or Ar7 rings (namely X9, X10, X11, or X12) must represent a halogen atom, alkylsulfonate group, arylsulfonate group, etc...

The list of substituents that one of X9, X10, X11, or X12 does not include alkyl, which is what the substituents are for the compound of Doi et al. Additionally, there is no rationale that the Examiner can apply that would allow for one of the methyl groups on the Ar6 or Ar7 rings to be changed for the various functional groups that are required for the proviso.

Conclusion

Claims 3 and 4 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Kosack whose telephone number is (571)272-5575. The examiner can normally be reached on M-Th 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph R Kosack/
Examiner, Art Unit 1626